it is inherent that the combination of Roehr's elements operate identically to the claimed invention. With respect to claim 20, the Examiner states that it is inherent that the fabric lined foil of Roehr means a foil wherein the fabric lined layer is that which would touch the patient. Further, the Examiner states that Roehr's fabric lined foil is a "laminated" structure. These rejections are traversed as follows.

Just as the Examiner's rejection can be traced back through a series of Office Actions beginning on December 8, 1997, the arguments to support the traversal of the rejection can likewise be traced through the Office Action Responses of April 3, 1998. Those responses are incorporated herein by reference.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Examiner states that it is inherent that the combination of Roehr's elements operate identically to the claimed invention. There is no extrinsic evidence in the Roehr disclosure to support the position that Roehr's combination of elements forms as inflatable structure as recited in the rejected claims. *In re Robertson* 169 F.3d 743, 49 USPQ2d, 1949, 1950 (Fed. Cir. 1999) restates the principle that to establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference..." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ 2d 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Id. at 1269, 20 USPQ2d at 1749. The Applicant repeats the request that the Examiner supply evidence that Roehr's device is "inflatable", and includes a "non-inflatable portion" near a "head end".

The Applicant's primary contention remains that there is no evidence to support the assumption that Roehr discloses an inflatable structure as recited in the claimed invention. In previous responses that Applicant has demonstrated that the prior art recognizes a distinction between "inflatable" and "non-inflated" structures, and that the word "inflation" never appears in the Roehr patent. Roehr describes a cover for the purpose of distributing air, which has been heated or cooled. Roehr provides a general description of apertures and welds to accomplish this distribution. In addition, Roehr describes a warm air generating device 70 with a blower 75 to

"...suck in air through the housing opening 72a which is then pushed into the interior 13 of the cover 10..." (pg. 6, sixth paragraph). However, at no point does Roehr provide a description of a cover with apertures so small, pressure so great, or a structure which causes the cover to inflate. Roehr simply fails to describe an inflatable structure as recited in the claimed invention.

The Examiner further states that Roehr discloses a "...noninflatable portion beyond the edge weld 15 as can be best seen in Fig. 1." In the second-last paragraph of page 4 (Roehr-English translation), it states that the two layers of material 11, 111 are welded or glued in the area where their continuous borders 12 are located. This is the only description of weld 15 made in the document. Roehr's Fig. 1 is a top view of the cover, which provides no information concerning the cover thickness. Fig. 2 of the Roehr patent clearly shows weld 15 as an edge, forming the periphery 12 of the cover. A thickness can clearly be seen out to the weld 15, but not beyond it. If the Examiner's contention is that Roehr's cover is inflatable, then it is inflatable all the way to the periphery. Alternately, if the cover has a non-inflated portion along the periphery, then the entire cover is not inflated. At page 5, ln. 29 to page 6, ln. 3 of the claimed invention, a non-inflated blanket recess 22 is described as smooth and flat when the blanket is inflated. The edge formed by weld 15 in Roehr cannot be described as resembling the smooth flat surface of the claimed invention non-inflatable portion.

In addition, the Applicant requests that the Examiner provide evidence to support the other above-mentioned conclusions made on the basis of inherency. Namely, that Roehr's fabric lined plastic foil means a foil wherein the fabric lined layer is that which would touch the patient, so as to not interfere with the welds in the blanket. In an Examiner's Answer to an Appeal Brief filed with regard to Serial No. 08/846,089, Augustine et al., THERMAL BLANKET, filed May 16, 1997, the Examiner discusses the Roehr disclosure and comes to a completely different conclusion. In the above-referenced Answer the Examiner states that fabric must be outside that plastic foil, so as to not interfere with the plastic welds. The Examiner's confusion stems from Roehr's lack of description, and is evidence that there is no inherent arrangement of Roehr's layers as set forth in the rejected claims.

Also, the Examiner is requested to provide evidence that Roehr's fabric lined foil describes a "laminated" structure. Webster's Dictionary defines the word laminated as, "2 a: composed of layers of firmly united material b : made of bonding or impregnating superposed

layers (as of paper, wood, or fabric) with resin and compressed under heat." Note the definition is already of record. A copy of the definition is enclosed for the Examiner's convenience. The Applicant is unable to find a specific explanation in the reference of the bond between the fabric and foil layers.

As mentioned in previous responses, Roehr does not disclose the order of the layers recited in the claimed invention. Neither is there evidence that Roehr describes an inflatable structure, a structure made of laminated layers, or a structure with a non-inflatable portion, which are all the elements of claim 20. Since the Examiner has failed to provide support for his arguments based on either inherent evidence or cites from the reference, the Examiner is respectfully requests to remove his rejection of this claim. Claims 21, 22 and 34, dependent from claim 20, also benefit from the above-mentioned distinctions between the claimed invention and the prior art.

The Examiner has rejected claims 23 and 25-31 as obvious under 35 U.S.C. 103(a) over Roehr for reasons set forth in previous Actions. In the December 8, 1997 Office Action the Examiner states that (regarding claims 23, 28, and 31) that the use of paper as a substitute for fabric in a disposable article is well known, and that the use of a fabric layer closest to the patient is obvious (claims 25-30). In the Office Action of June 23, 1998, the Examiner states that he is under no obligation to establish that paper is a likely choice to an ordinarily skilled artisan.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

There is no suggestion to modify Roehr in such a manner as to describe an inflatable cover, where the base sheet includes an under layer of paper, as recited in the claimed invention. In the summarized claim in the last paragraph of page 2 (section a), in the summarized claim on

page 3, and in the claims 1 and 2, Roehr simply describes layers consisting of weldable plastic foil or a fabric lined with plastic foil.

If the Examiner is relying upon officially noticed fact of cloth substitutes to support a suggestion of obviousness, the Examiner is required to supply an affidavit supporting such a position. The right to request such an affidavit is clearly enunciated in *In re Ahlert* 424 F.2d 1088, 1091, 165 USPQ 418, 420-421 (CCPA 1970), CFR 1.104(d)(2), and summarized in MPEP 2144.03.

The inventor's disclosure cannot be used as a blueprint for piecing together the prior art to defeat patentability, which is the essence of hindsight. *In re Dembiczak*, 175 F.3d 994, 999, U.S.P.Q.2d 1614. There is nothing in the teachings of Roehr to suggest the inflatable structure of the claimed invention. The Applicant respectfully submits that the cited prior art is only modified in retrospect, in light of the present invention. That is, the obviousness rejection is based upon the Applicant's own invention characterization, not the modification of Roehr.

Further, the Examiner has still not demonstrated that the modification of the cited the prior art reference points to the reasonable expectation of success in the present invention, which is the second requirement of the obviousness analysis.

With respect to the third requirement to support a *prima facie* case of obviousness, as noted in the response to the anticipation rejection, Roehr does not disclose all the elements of the claimed invention of claim 20. Roehr does not describe the claimed invention inflatable structure, non-inflatable portion, or laminated structure. Claims 23 and 25-31, dependent from claim 1, also benefit from the above-mentioned distinctions between Roehr and the claimed invention of claim 20. Since Roehr neither suggests, nor contains all the elements of the claimed invention, the Examiner is requested to withdraw his rejection.

The Examiner has rejected claims 32 and 33 as obvious under 35 U.S.C. 103(a) over Augustine '188, in view of Roehr for reasons set forth in previous Office Actions. In the Office Action of December 8, 1997, the Examiner has stated that, "(i)n view of Roehr it would have been obvious to one of ordinary skill in the art to have used a fibrous layer on Augustine's blanket for the purposes of comfort." This rejection is traversed as follows.

"Comfort" is the Examiner's word and the Examiner's notion; it is unsupported by any explicit passage in Roehr or in Augustine, or by any extrinsic evidence introduced by the

Examiner. In fact, the laminated structure, in which one layer is thin (plastic) and the lower side outer layer is "fibrous" is useful for increasing the "the frictional characteristics" of the material of which an inflatable cover is formed. See U.S. Patent No. 5,246,656, C.1, Il. 28-30. But this was apparent to the skilled artisan only after the claimed invention became generally known.

The Examiner has not suggested how the combination of Augustine ('188) with Roehr points to a reasonable expectation of success with respect to the claimed invention.

With respect to the third *prima facie* requirement, the Augustine ('188) inflatable structure is described as a semi-tubular structure. The combination of Augustine ('188) with Roehr's fabric lined plastic still fails to teach all the element of an inflatable structure as recited in the claimed invention of claim 20, and supported in the specification. Claims 32 and 33, dependent from claim 20, also benefit from the above-mentioned distinctions between the cited prior art and the claimed invention. Since the combination of prior art neither suggests, nor contains all the elements of the invention of claim 20, the Examiner is requested to withdraw his rejection.

The Examiner has rejected claims 35 and 36 as obvious under 35 U.S.C. 103(a) over Roehr in view of Hardy for reasons set forth in earlier Actions. In the Office Action of December 8, 1997, the Examiner has stated that it would have been obvious to modify Roehr's cover to provide a non-inflatable recess in view of Hardy. In the Office Action of June 23, 1998, the Examiner acknowledges that Hardy's opening is nothing but air, making it uninflatable. In the Action of February 14 the Examiner states that Hardy provides a motivation to combine references, stating that such an advantage would have been apparent to one skilled in the art. This rejection is traversed as follows.

Hardy's structure is not inflatable, and neither Hardy nor Roehr includes any kind of motivation or suggestion to form a non-inflatable section in an inflatable blanket to observe a patient's head region. The Examiner states that Hardy provides motivation, in that it would have been apparent to a skilled artisan to combine air and fluid thermal references. This is a conclusion, unsupported by reasoning. If the Examiner is correct in his conclusion, however, there must be some features in the Hardy invention which the Examiner can describe which suggests a reason to combine the Hardy invention with Roehr. As is plainly stated in MPEP 2143.01, the fact that references can be combined does not demonstrate a motive to combine In

re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Likewise, the fact that a modification would be within the ordinary skill of the art is not proof of motivation Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). Therefore, with respect to the first prima facie obviousness requirement, it is not readily apparent how a fluid thermal device could suggest modifications to an air thermal device. Further, it is not readily apparent how a recess in a fluid thermal device could suggest a non-inflatable portion defining a recess in an air distribution device.

Likewise, the Examiner has provided no reason to suppose that a combination of Roehr with Hardy would point success in the claimed invention, in accordance with the second *prima* facie obviousness requirement.

The Examiner has rejected claims 37-39 as obvious under 35 U.S.C. 103(a) over Augustine ('188) in view of Roehr and Hardy for reasons set forth in the Examiner's earlier applications of Roehr and Hardy. This rejection is traversed as follows.

With respect to the first *prima facie* requirement that Applicant has demonstrated above that there is no motivation to combine Augustine ('188) with Roehr, or Roehr with Hardy. Again the Examiner has combined a group of prior art references without providing a motive to combine the references, or a reason to suggest that the combination points to success in the claimed invention. Likewise, the combination of Augustine's tubular structure, with Roehr's air distribution system and Hardy's fluid thermal system, fails to teach the inflatable structure of the claimed invention of claim 35. Claims 37-39, dependent from claim 35 also benefit from the above-mentioned distinctions. Since the cited prior art neither contains all the elements, nor suggests the claimed invention, the Examiner is respectfully requested to withdraw the rejection.

The Examiner states that claim 24 would be allowed if rewritten in independent form including the subject matter of base and intervening claims.

It is believed that this application is now in condition for allowance and reconsideration is earnestly solicited.

Date: 14 Jul 2000

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lamé
land

la.mé Vià-mà, la-\ n [F]: a brocaded clothing fabric made from any of various fibers combined with tinsel filling threads often of gold or silver the silver that the silver t

behind in achievement: WEAKLING lamell- or lamelli- comb form [NL, fr. lamella]: lamella < lamelli- (orm) < lamelli- comb form [NL, fr. lamella]: lamella < lamelli- (orm) < lamella \lamella \l

or part: as a: one of the thin plates composing his plane or bivalve mollusk b: a gill of a mushroom — la-mel-lar \-mel-ar\-me

Is -men-ta-ble \fram-on-ta-bol, la-ment-a-\ adj 1: that is to be regretted or lamented: DEPLORABLE 2: expressing grief: MOURN-FUL—lamen-ta-ble-ness n—lamen-ta-bly\-ble\ adv lamen-ta-tion\lam-on-ta-ba-on\ n: an act or instance of lament-

ing
Lamen-ta-tions \-shonz\ n pl but sing in constr: a poetic book on
the fall of Jerusalem in canonical Jewish and Christian Scripture —

see BIBLE table lament-ad\adj: mourned for — lament-ad\y adv lament-ad\\adj: mourned for — lament-ad-ly adv lamia \lambda \frac{1}{a} \text{-ment-ad} \adj: mourned for — lament-ad-ly adv lamia \lambda \frac{1}{a} \text{-ment-ad} \adj: mourned for — lamina <\lambda \frac{1}{a} \text{-more} \frac{

bling laminae

ismi-nar (lam->-nar(ad): arranged in, consisting of, or resembling laminae
laminar flow n: streamline flow in a viscous fluid near a solid
boundary — compare TURBULENT FLOW
lami-naria \lam->-her-\lambda-3, -har-\n [NL]
genus name]: any of a genus (Laminaria) of
large chiefly perennial kelps with an unbranched
cylindrical or flattened stipe and a smooth or
convoluted blade: broadly: any of various
related kelps (order Laminariales) — laminar-in-n \-\lambda->-n\lambda n: \lambda n = \lambda n

vnál - or

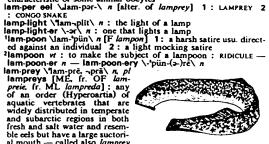
\\\nail-or\ n\\\\nail-or\ n\\\nail\ \adj\ 1: consisting of laminate 2: bearing or covered with laminae laminate 2: bearing or covered with laminae laminate 2: bearing or covered with laminate laminated \\\nail\ nail\ n\\\nail\ n\\\nail\ nail\ n\\\nail\ n\\\nail\

NA.

Ammas \lam-as\n [ME Lammasse, fr. OE hlāfmæsse, fr. hlāfbal, bread + mæsse mass; fr. the fact that formerly loaves from the first ripe grain were consecrated on this day] 1: August 1 orig. celebrated in England as a harvest festival — called also Lammas Day 2: the time of the year around Lammas Day Lammastide n: LAMMAS 2 mmer-gel-or or lam-mer-gey-or \lam-ar-all-on\n n [G lämmer-see]: a large Eurasian vulture (Gypaetus barbotus aureus) that occurs in mountain regions from the Pyrenees to northern China and in flight resembles a huge falcon

lamp \1amp\ n [ME, fr. OF lampe, fr. L lampas, fr. Gk, fr. lampein to shine; akin to ON leiptr lightning] 1 a: a vessel with a wick for burning an inflammable liquid (as oil) to produce artificial light b: any of various devices for producing light or heat 2: a celestial body 3: a source of intellectual or spiritual illumination lamp-black _blakk n: a finely powdered black soot deposited in incomplete combustion of carbonaceous materials and used chiefly as a superset (as in pairts, cannots and cription ink).

ble eels but have a large suctori-al mouth — called also lamprey



lamprey

ble cels but have a large suctorial mouth — called also lamprey
cel lamp-shell \1amp-shel\ n [fr.
the resemblance of the shell and its protruding peduncle to an ancient oil lamp with the wick protruding]: BRACHIOPOD
lam-ster \1am(p\)-stor\ also lam-is-ter \1amp\-stor\ n [21am +
-ster]: a fugitive esp. from the law
la-nai \1o-ni, li-\ n [Hawaiian]: PORCH. YERANDA
Lan-cas-tri-an \1an-r\kas-tri-5-n, lan-\ adj [John of Gaunt, duke of
Lancaster \1399]: of or relating to the English royal house that
ruled from 1399 to 1461
llance \1an(t)\lambda\ n [ME fr. OF, fr. L lanceo] 1: a weapon of war
consisting of a long shaft with a sharp steel head carried by
mounted knights or light cavalry 2: any of various sharp objects
suggestive of a lance: as a: LANCET b: a spear used for killing
whales 3: LANCET lb

2lance wb lanced; lanc-ing [ME launcen, fr. MF lancer, fr. LL
lanceare, fr. L lancea] wt 1a: to pierce with or as if with a lance
b: to open with or as if with a lancet <~ a boil> 2: to throw
forward: HURL ~ wi: to move forward quickly
lance corporal n [lance (as in obs. lancepessade lance corporal, fr.
MF lancepessade): an enlisted man in the marine corps ranking
above a private [irst class and below a corporal
lance-let \1an(t)-sla\ n: any of various small translucent marine
animals (subphylum Cephalochordata) related to the vertebrates—
called also amphioxus
Lan-ce-lot \1an(t)-ss-J\ata, \1\ata(t), \(s(>-)\ata) \) n [F]: a knight of the
Round Table and lover of Queen Guinevere
lan-ce-olate \1an(t)-ss-J\ata, \1\ata(t), \(s(>-)\ata) \) n [F]: a knight of the
Round Table and sometimes at the base <~ leaves> <~
prisms> — lan-ce-olate \1\an(t)-ss-J\ata, \ata (t) \) a shaped like a lance head; specif: tapering to a
point at the apex and sometimes at the base <~ leaves> <~
prisms> — lan-ce-olate \1\an(t)-ss-J\ata, \ata (t) \and the lance \text{ so or such dances}
lan-cet \1an(t)-ss-\alpha \and the \text{ so or such dances}
lan-cet \1an(t)-ss-\alpha \and the \text{ so or such dances}
lan-cet \1an(t)-ss-\alpha \and the \text{

lancet window n: a high narrow window with an acutely pointed

windows

lancet window n: a high narrow window with an acutely pointed head and without tracery

lance-wood \lan(t)\-swud\ n: a tough elastic wood used esp. for shafts, fishing rods, and bows; also: a tree (esp. Oxandra lanceolata) yielding this wood lan-ci-nate \lan(t)\-ss-nāt\ wo-nat-ed; -nat-ing [L lancinatus, pp. of lancinare; akin to L lacer mangled — more at LACERATE]: PIERCE STAB — lan-ci-nat-ion \lan(t)\-ss-\nās-shnn\ n

Lancs abbr Lancashire

land \land\ no flen atitib [ME, fr. OE; akin to OHG lant land, OIr land open space] 1 a: the solid part of the surface of the earth; also: a corresponding part of another celestial body (as the moon) b: ground or soil of a specified situation, nature, or quality <wet ~> c: the surface of the earth and all its natural resources 2: a portion of the earth's solid surface distinguishable by boundaries or ownership: as a: COUNTRY <campaigned in every corner of the ~> b: privately or publicly owned land <had some ~ in the country> 3: REALM, DOMAIN <in the ~ of dreams> 4: the people of a country <had shaded of the country of the resemble of the surface of that is left without machining — land-leas \land \land \land \land \land 1: to set or put on shore from a ship: DISEMBARK 2 a: to set down after conveying b: to cause to reach or come to rest in a particular place <never ~ed a punch> c: to bring to a

* kitten ar further a back a bake abut ch chin e less è easy g gift i trip i life aù out 9 sing o flow o flaw ol coin the thin the this i ioke y yet yii few yii furious ü loot ù foot